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Paper No. 11

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In re Application of
Ramakrishnan et al.
Application No. 09/775,803
Filed: February 5, 2001
Attorney Docket No. 44481-5044-01 US

TECH CENTER: 1600/2900

OFFICE OF PETITIONS

DECISION DISMISSING PETITION

This is a decision on the petition under 37 CFR 1.47(a), filed on October 9, 2001, requesting that 1 of the 2 joint-inventors be allowed to file the application on behalf of himself and the other joint-inventor who allegedly refuses to join in this application.

The petition is **DISMISSED**.

There are 2 joint-inventors for the claimed invention in this application: Vanitha Ramakrishnan ("Ramakrishnan") and David R. Phillips ("Phillips"). On March 9, 2001, a Notice to File Missing Parts of Nonprovisional Application was mailed, indicating that the application as filed on February 5, 2001 lacked, *inter alia*, a properly signed oath or declaration as required by 37 CFR 1.51(b)(2) and as specified in 37 CFR 1.63.¹ Applicants were given an extendable, 2-month non-statutory period within which to submit the missing items.² In response, the instant petition was filed.³

The petition encloses a "Combined Declaration for Patent Application and Power of Attorney" signed only by Phillips ("10/9/01 Declaration"), and requests that Phillips be allowed to file this application on behalf of himself, and, of Ramakrishnan who allegedly refuses to join in this application.

Phillips may file this application on behalf of himself as well as of Ramakrishnan, provided that a **bona fide attempt** has been made to present to Ramakrishnan, for signature, a copy of the entire application, including the specification, claims, drawings, and declaration; and that the latter

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OFFICE OF PETITIONS

Docketed 5-15-02 Attorney MST/ECW/SEZ
Case 44481-5044-01
Due Date 7-10-02
Action Declaration/Renewed Petition Due
By SDW Ctk BR

¹ Other missing items in the 2/5/01 application included the basic filing fee for this application and the extra claims fees.

² The 2-month period for responding to a Notice to File Missing Parts is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions under 37 CFR 1.136(a) of up to 5 months, i.e., through 10/9/01 at the maximum, are permitted. See MPEP 710.02(d) (Aug. 2001).

RECEIVED The petition is timely, in that, it encloses a request for a 5-month extension of time for filing the missing items, and the \$980 extension-of-time fee (small entity). See *infra*.

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refuses to join in this application.⁴ The oath or declaration in such an application must be accompanied by a petition under 37 CFR 1.47(a) which includes, *inter alia*, Ramakrishnan's last known address,⁵ and a statement of facts, by those who presented the application papers/ concluded that Ramakrishnan refused to join in/to whom the refusal to join in was made, concerning the circumstances of the presentation of the application and the subsequent refusal.⁶

The instant petition relies solely on a "Statement Of Facts In Support Of Petition Filed Under 37 CFR 1.47" signed by a Carmen Ekstrom ("Ekstrom Statement"). The Ekstrom Statement sets forth that:

- (1) On 3/7/01, Ramakrishnan was contacted by "COR"⁷ and asked to sign the combined Power of Attorney and Declaration for this application;⁸
- (2) Ramakrishnan responded by e-mail to a Carolyn Adler . . . ;⁹
- (3) On 8/20/01, a Gayle Wolfe . . . sent a letter to . . . Ramakrishnan . . . at her last known address 825 Holly Road., Belmont, CA 94002 . . . Along with the letter was a package containing the patent application . . . The package was . . . signed by H. Heiser;¹⁰
- (4) On 9/19/01, Gayle Wolfe sent another letter and package . . . to Ramakrishnan at her last recorded address 825 Holly Road, Belmont, CA 94002 . . . The package contained the patent application . . . [T]he return receipt was

⁴ See also MPEP section 409.03(d) (Aug. 2001), REFUSAL TO JOIN (A refusal by an inventor to sign an oath/declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join in the application unless it is clear that the inventor understands exactly what he is being asked to sign and refuses to accept the application papers.); also citing *In re Gray*, 115 U.S.P.Q. 80 (Comm'r Pat. 1956) (It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath/declaration is directed.).

⁵ 37 CFR 1.47(a); MPEP section 409.03(e) (Aug. 2001) (An application filed under 37 CFR 1.47 must state the last known address of the non-signing inventor . . . at which the inventor customarily receives mail, . . . [o]rdinarily . . . the last known residence); and MPEP section 605.03 (Aug. 2001) ([T]he [nonsigning] inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary).

⁶ See MPEP section 409.03(d) (Aug. 2001) (When the 37 CFR 1.47 applicant concludes that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made).

⁷ Apparently the assignee of rights to this application.

⁸ Ekstrom Statement, Page 1, paragraph 2, 1st sentence.

⁹ Ekstrom Statement, Page 1, paragraph 2, 2nd sentence.

¹⁰ Ekstrom Statement, Page 2, paragraph 3.

- signed by a Heather Heiser . . .¹¹
- (5) On 9/27/01, Ekstrom contacted Ramakrishnan by telephone, and "asked her if she received the documents" . . . She said she . . . did not remember;¹²
- (6) On 9/28/01, Ramakrishnan called Ekstrom and "agreed to sign the . . . Declaration . . . Ekstrom went to Ramakrishnan's place of employment and handed her "a copy of this application . . . Ramakrishnan did not want to sign at that time. She indicated she wanted to review them first";¹³
- (7) On 10/1/01, Gayle Wolfe went to pick up the signed documents . . . they were not at the reception desk . . . and Ramakrishnan did not respond to the intercom or come to the front desk;¹⁴
- (8) On 10/1/01, Ekstrom called Ramakrishnan, the latter has not returned the call as of 10/9/01.¹⁵

The Ekstrom Statement:

- does not indicate **who** on behalf of "COR" contacted Ramakrishnan on 3/7/01 regarding the application declaration, **how** Ramakrishnan was contacted on that day, or whether the "contact" was merely an inquiry without giving Ramakrishnan, previously or concurrently, an entire copy of the application papers for Ramakrishnan's review;¹⁶
- does not specify whether a copy of the **entire** application, including the specification, claims, drawings, was ever provided to Ramakrishnan for review;¹⁷
- does not show that the 2 alleged mailings signed by a "Heiser" were subsequently received by Ramakrishnan;¹⁸ and

¹¹ Ekstrom Statement, Page 2, paragraph 4.

¹² Ekstrom Statement, Page 2, paragraph 5, lines 1, 4-5.

¹³ Ekstrom Statement, Page 3, paragraph 6, lines 1-2, 5-6, 9-10.

¹⁴ Ekstrom Statement, Page 3, paragraph 7.

¹⁵ Ekstrom Statement, Page 3, paragraph 8.

¹⁶ See item (1) above.

¹⁷ This application claims a highly complex subject matter: "Transgenic Animals Having a Modified Glycoprotein V Gene"; and contains an 18-page sequence listing, a 31-page Specification including 27 claims, a 2-page preliminary amendment, and 9 figures of drawings. It is not clear, from the Ekstrom Statement, whether an entire copy of the application papers had been provided to Ramakrishnan prior to 9/28/01, and if so, whether she was given reasonably sufficient time to review the papers. If Ramakrishnan received on 9/28/01, for the first time, an entire copy of the application papers, her lack of response by 10/9/01, less than 2 weeks away, cannot reasonably be construed as her refusal to join in this application.

¹⁸ See items (3), (4) & (5) above. It is not clear whether Ramakrishnan received such mail, i.e., whether "Heiser" is the current occupant at that address and Ramakrishnan no longer resides there.

-is largely based on hearsay.¹⁹

Consequently, the Office is unable to conclude that the Ekstrom Statement constitutes the "statement of facts" required for establishing that a *bona fide* attempt has been made to present to Ramakrishnan for signature a copy of the entire application, including the specification, claims, drawings, and declaration; and that the latter refuses to join in this application. The petition is thus dismissed and the 10/9/01 Declaration is not accepted.

To prevent abandonment of this application,²⁰ an oath or declaration signed by both Ramakrishnan and Phillips,²¹ or, a renewed petition, must be submitted within **TWO (2) MONTHS** from the mailing date of this decision, unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained.

A renewed petition under 37 CFR 1.47(a) must include:

- appropriate **statement(s) of facts**, establishing that a *bona fide* attempt has been made to present to Ramakrishnan for signature, at her **last known address**,²² a copy of the **entire** application, including the specification, claims, drawings, and declaration; and of the **facts** relied upon to conclude that Ramakrishnan has refused to join in this application;²³

- a \$130 petition fee;

and should be addressed as follows:

- by mail and by hand: Assistant Commissioner for Patents
USPTO
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

- by fax: (703)308-6916
Attn: Office of Petitions

¹⁹ See items (2), (3), (4), (7).

²⁰ See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by §1.16(e) to avoid abandonment.).

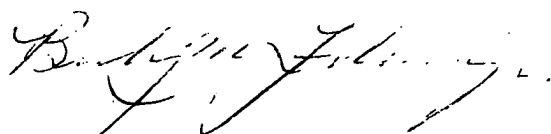
²¹ Submit directly to the Office of Initial Patent Examination (OIPE).

²² The Ekstrom Statement does not explain why Ramakrishnan was visited/contacted at her place of employment rather than at her last known residence address.

²³ The statement(s) of facts must be signed by those who presented the application/made the stated contacts/concluded that Ramakrishnan has refused to join in/to whom the refusal to join in was made.

Finally, the Office acknowledges receipt with the instant petition of: the \$130 petition fee; the \$65 surcharge for late filing of the 10/9/01 Declaration (small entity); the \$370 application filing fee (small entity); the \$63 for 7 claims in excess of 20 (small entity);²⁴ the \$84 for 2 independent claims in excess of 3 (small entity); and the \$140 for filing multiple dependent claims (small entity). As authorized, the \$65 surcharge for late filing of the basic filing fee (small entity) has been charged to Deposit Account No. 50-0310.

Telephone inquiries concerning this decision should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

²⁴ There are only 27 claims (@\$9/extra claim). \$72 was paid. The overpayment of \$9 has been credited to Deposit Account No. 50-0310 as authorized in the "Response To Notice To File Missing parts" enclosed with the instant petition.